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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/563,909

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Marco Pirovano

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NIXON & VANDERHYE, PC

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EXAMINER

MEHTA, BHISMA

ART UNIT

PAPER NUMBER

3767

MAIL DATE

DELIVERY MODE

08/06/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/563,909

**Applicant(s)**

PIROVANO ET AL.

**Examiner**

BHISMA MEHTA

**Art Unit**

3767

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 38, 40, 41, 43, 45-48, 50-52 and 54-74 is/are pending in the application.
- 4a) Of the above claim(s) 60-74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38, 40, 41, 43, 45-48, 50-52 and 54-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 7 2008 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 38, 40, 41, and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Corbin et al (U.S. Patent No. 3,252,623). Corbin et al disclose an infusion system having a pumping device (14) for generating a flow of a solution to a catheter, an adjusting device (24) to vary the flow, and a command and control device (45). The adjusting device comprises a valve arrangement in the form of a solenoid valve which is normally closed. The command and control device is configured to operate the valve arrangement to command a pulsed actuation of the valve arrangement (see lines 16-26 and lines 51-60 of column 3). The flow of the solution is

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determined by the number of actuations of the valve arrangement per unit time (see lines 1-26 and lines 51-60 of column 3). The pulsed actuations are made according to an infusion cycle of the solution as Corbin et al disclose the frequency of output pulses from an impulse generator corresponding to the selected drop rate of the liquid to be fed to a patient being inputted into the command and control device which then leads to a certain number of actuations of the valve arrangement per unit time. The command and control device is provided with an electric supply apparatus which is connected to the command and control device by a channel (35).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 43 and 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corbin et al in view of Franetzki et al (U.S. Patent No. 4,270,532). Corbin et al disclose the system substantially as claimed. However, Corbin et al are silent on the specifics of the command and control device comprising a microprocessor, an interface element, or a reading device. Franetzki et al disclose an infusion system having a container, a pumping device, and a command and control device comprising a microprocessor (I). The command and control device also has an interface element for operationally connecting the command and control device to a data processing system

(44) and a reading device for receiving a data recording support in the form of a smart-card type (lines 38-52 of column 2 and lines 3-24 of column 7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the command and control device of Corbin et al with a microprocessor or an interface element as taught by Franetzki et al as Franetzki et al disclose that it is well known to use a command and control device having a microprocessor or an interface element to allow the desired infusion to be pre-programmed and monitored by a physician. To provide the command and control device of Corbin et al with a reading device as taught by Franetzki et al would have also been obvious to one having ordinary skill in the art at the time the invention was made as Franetzki et al disclose that it is well known to use a command and control device having a reading device to allow for the programming data which is already stored on a carrier or card to be easily read by the command and control device.

6. Claims 45-48 and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corbin et al in view of Kanai et al (U.S. Patent No. 6,367,502).

Corbin et al disclose the system substantially as claimed. However, Corbin et al are silent on the pumping device comprising an elastomeric container. Kanai et al disclose an infusion system having a pumping device comprising an elastomeric container (11) which is supported on a support element (10) associated with a transparent containing and protection element (2). The containing and protection element has a scale (4). The containing and protection element has an inlet portion (19) with a check valve (13) and a connecting element (17) and an outlet portion (18) which is connected to a first end of

a fitting element (30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the pumping device of Corbin et al with the pumping device having an elastomeric container as taught by Kanai et al as both Corbin et al and Kanai et al disclose infusion systems having a pumping device and the pumping device of Kanai et al could be used in the infusion system of Corbin et al as an equivalent way of generating a flow of solution.

7. Claims 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corbin et al in view of Crankshaw et al (U.S. Patent No. 4,741,732). Corbin et al disclose the system substantially as claimed. However, Corbin et al are silent on the electrical supply apparatus being a battery. Crankshaw et al disclose an infusion system with a command and control device (120) having a rechargeable battery (129). It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the electrical supply apparatus of Corbin et al with the rechargeable battery as taught by Crankshaw et al as Crankshaw et al teach that it is well known to use rechargeable batteries to provide the power needed to operate a command and control device in an infusion system.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 38, 40, 41, 43, 45-48, 50-52, and 54-59 have been considered but are moot in view of the new ground(s) of rejection. As to Applicant's arguments in line 11 of page 11 to line 2 of page 12, the device (14) of Corbin et al is capable of being placed at a level higher than the level at which the

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catheter is inserted into a patient's body and, therefore, is considered to be a pumping device. Also, as stated previously, it is an apparatus that forces or draws a liquid from or to another part of a system. In response to applicant's argument that the device (14) of Corbin et al does not constitute a pumping device and that Applicant's pumping device does not require placement at a level higher than the level at which the catheter is inserted, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BHISMA MEHTA whose telephone number is (571)272-3383. The examiner can normally be reached on Monday through Friday, 7:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on 571-272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bhisma Mehta/

Examiner, Art Unit 3767

/Kevin C. Simons/

Supervisory Patent Examiner, Art Unit 3767